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EXAMINER

ROSSI, JESSICA

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1733

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/637,242
Filing Date: August 14, 2000
Appellant(s): ST.JOHN, CALI

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Mr. Van Der Wall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 3/13/06 appealing from the Office action mailed 10/6/04.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 3,690 509	Kinoian et al.	9-1972
US 6,354,645	Bozlee	3-2002
JP 6-171650	Kagami	6-1994
US 6,127,437	Burns	10-2000

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US 4,402,421	Ruemer, Jr.	9-1983
US 6,015,059	Takayama	1-2000
US 6,620,281	Sommers	9-2003
US 5,925,208	Dronzek, Jr.	7-1999
US 5,863,624	Miyazaki et al.	1-1999

Kinoian is directed to a method for a protective member manufacturer relating to beverage containers. The reference teaches manufacturing a consumer removed flexible protective member, applying advertising indicia to the protective member, and adhering the protective member to a container to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of the mouth contact area of the container.

Bozlee is directed to a method of doing business relating to advertising where the manufacturer of an item sells the right to an entity (3rd party) to advertise on the item and the manufacturer of the item then gives the item to a retailer who then distributes the item to consumers along with the goods being purchased from the retailer's store. For example, the reference teaches the manufacturer of a bag handle selling the rights to a pizza company to advertise on the handles and then giving the handles to a grocery store to attach to their grocery bags, where the advertising revenue generated allows the bag handle manufacturer to penetrate the market by giving the handles away freely to the grocery store.

Kagami is directed to an hourglass-shaped protective member adhered to a top and convex side of a beverage can.

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Burns is directed to treating a plastic closure for a liquid container using corona discharge so that the closure accepts and retains printed matter.

Ruemer is directed to covering the top of a beverage container with a protective member bearing indicia used for such things as redeemable prizes.

Takayama is directed to using an antibacterial adhesive for attaching a flexible protective member to a beverage container.

Dronzek is directed to imposing anti-static chemical treatment to adhesively-backed labels having indicia printed thereon.

Sommers is directed to applying an adhesively-backed label to a beverage can using a cut and stack method that involves high speed dispensing of labels placed on top of each other in a stack.

Miyazaki is directed to increasing bond strength between an adhesive and a plastic layer in the label art by imposing treatment to the surface of the plastic layer before applying the adhesive thereto.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-5 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kionoian et al. (US 3690509, of record) in view of Bozlee (US 6354645, of record), as set forth in paragraph 9 of the final office action.

With respect to claim 1, Kinoisian is directed to a method for a protective member manufacturer relating to beverage containers. The reference teaches manufacturing consumer removed, flexible protective member 10 (Figure 1; column 2, lines 43-50), applying advertising indicia 23 to the protective member (Figure 1; column 3, lines 27-30), and adhering the protective member to the container 11 to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of the mouth contact area of the container (Figure 1; column 3, lines 10-25; column 4, lines 24-25).

The reference is silent as to the protective member manufacturer conveying by profit making sale to third party advertisers a right to attach indicia to the protective member.

It is known to engage in a method of doing business relating to advertising where the manufacturer of an item sells the right to an entity (3rd party) to advertise on the item and the manufacturer of the item then gives the item to a retailer who then distributes the item to consumers along with the goods being purchased from the retailer's store, as taught by Bozlee (Figure 2; column 3, lines 1-5 and 22-26 and 36-38). For example, Bozlee teaches the manufacturer of a bag handle selling the rights to a pizza company to advertise on the handles and then giving the handles to a grocery store to attach to their grocery bags, where the advertising revenue generated allows the bag handle manufacturer to penetrate the market by giving the handles away freely to the grocery store. The skilled artisan would have readily appreciated that this revenue would have to be in the form of profit; otherwise, the handle manufacturer would not be able to give away his product without his business going under.

Therefore, it would have been obvious to one of ordinary skill in the art to at the time the invention was made to have the protective member manufacturer convey by profit making sale to

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third party advertisers a right to attach the advertising indicia to the protective members of Kinoian because such is a known business method in the advertising industry, as taught by Bozlee, and it creates a business for a fourth party (protective member manufacturer being neither the advertiser, can filler, nor consumer).

Regarding claim 2, Bozlee teaches the third party advertiser, or pizza company, being neither the bag distributor (= can filler) nor the handle manufacturer (= protective member manufacturer).

Regarding claim 4, Kinoian teaches sanitizing at least a portion of the can (column 3, lines 40-45).

Regarding claim 5, Kinoian teaches the indicia being advertising or instructions (column 3, lines 29-30).

Regarding claim 12, Kinoian teaches adhering the members using adhesive (column 3, lines 10-20).

Claims 3, 6, 9-10 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Kagami (JP 6-171650, of record), as set forth in paragraph 10 of the final action.

Regarding claim 3, Kinoian teaches the protective member not being limited to a particular configuration wherein the configuration facilitates adherence to a top and convex side of a can without deformation and without wrinkling of the member by folding it over a rim of the container when adherence occurs (Figures 1 and 3-6). However, the reference is silent as to an hourglass configuration.

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It would have been obvious to the skilled artisan at the time the invention was made to use an hourglass configuration for the protective member of Kinoian because it is known to adhere an hourglass-shaped protective member to a top and convex side of a beverage can, as taught by Kagami (Figures 3-4; section [0010] written translation), wherein such a configuration conforms to the contours of the can well. Note similarities between shape of protective member of Kagami and protective member of present invention as shown in Figure 4. Therefore, the skilled artisan would have appreciated that the hourglass configuration of the protective member of Kagami would facilitate this adherence without deformation or wrinkling.

Regarding claim 6, Kinoian is silent as to applying the indicia by printing. It would have been obvious to the skilled artisan to apply the indicia by printing because such is known in the art, as taught by Kagami (section [0007] of written translation)), wherein such a technique works well with plastic.

Regarding claims 9-10, Kagami teaches applying the printed indicia to an underside of an opaque protective member ([0007] of written translation). It would have been obvious to have the protective member of Kinoian be opaque with indicia applied to the underside thereof because such is known in the art, as taught by Kagami, thereby peeking the curiosity of the consumer who cannot read the indicia until they have been purchased the container and removed the protective member.

With respect to claim 16, all the limitations were addressed above with respect to claim 3.

Claims 7-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al., Bozlee and Kagami as applied to claim 6 above, and further in view of Burns (US 6127437, of record), as set forth in paragraph 11 of the final action.

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Regarding claims 7-8, Kinoian is silent as to treating the protective members using corona discharge so that the same accepts and retains printing ink. It is known to treat a plastic closure for a liquid container using corona discharge so that the closure accepts and retains printed matter, as taught by Burns (Figure 1; column 2, lines 51-56; column 5, lines 46-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the plastic protective member of Kinoian using corona discharge so that the member accepts and retains printed matter because such is known, as taught by Burns, and this ensures that the desired indicia successfully appears on the member.

Claims 11, 17 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al., Bozlee and Kagami as applied to claim 10 above, and further in view of Ruemer (US 4402421, of record), as set forth in paragraph 12 of the final action.

Regarding claim 11, Kinoian is silent as to the indicia being used for such things as those recited in the present claim.

It is known in the art to cover the top of a beverage container with a protective member bearing indicia used for such things as redeemable prizes, as taught by Ruemer (Figure 4; column 2, lines 23-25 and 49-51). One reading Kinoian as a whole would have appreciated that the reference is not limited to any particular type of advertising and therefore it would have been obvious to the skilled artisan at the time the invention was made to have the indicia printed on the underside of the members of Kagami be used for such things as redeemable prizes without the user knowing in advance of protective member removal which of a plurality of chances the user has obtained because such is known in the art, as taught by Ruemer, wherein such things peek the curiosity of consumers thereby increasing sales.

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Regarding claim 17, all the limitations were addressed above with respect to claim 11.

Regarding claim 19, Kinoian teaches the protective members can be completely removed from the containers and therefore the examiner would have appreciated that the members of Kinoian would be capable of being completely removed from the containers and collected by a consumer if he/she chose to do so (perhaps he/she collects advertisements for a hobby).

Claims 13 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 12 above, and further in view of Takayama (US 6015059, of record), as set forth in paragraph 13 of the previous action.

Regarding claim 13, Kinoian is silent as to the adhesive being antibacterial. It would have been obvious to the skilled artisan at the time the invention was made to use an antibacterial adhesive for the adhesive of Kinoian because such is known in the art, as taught by Takayama (column 3, lines 26-31), wherein this prevents any bacterial growth from forming in the areas having adhesive thereon.

Regarding claim 18, it would have been obvious to the skilled artisan at the time the invention was made to use an adhesive that allows for reattachment of the portion of the member that was removed to expose the pour spout because such is known in the art, as taught by Takayama (column 3, lines 1-7), wherein this prevents contamination of the contents within the can while also allowing for storage of an unfinished beverage until a later time.

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Dronzek (US 5925208, of record) and Sommers (US 6620281, of record), as set forth in paragraph 14 of the final action.

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Regarding claim 14, Kinoian is silent as to imposing anti-static chemical treatment on the protective members.

It is known to impose anti-static chemical treatment to adhesively backed labels having indicia printed thereon (note protective members similar to adhesively backed labels), as taught by Dronzek (column 8, lines 30-35 and 65-68). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to impose anti-static chemical treatment to the label-like protective members of Kinoian because such is known, as taught by Dronzek, wherein this would produce the expected results of preventing unwanted sticking/clinging. The skilled artisan would have appreciated that like the anti-static chemically treated members of the present invention, the anti-static chemically treated members of Kinoian would also slide easily from an adjoining member and not cling to it under high speed dispensing.

The examiner would like to point out that the present claim language is not positively claiming a method step of high speed dispensing of adjoining protective members. However, to expedite prosecution, the examiner would like to point out that it is known in the art to apply an adhesively-backed label to a beverage can using a cut and stack method that involves high speed dispensing of labels placed on top of each other in a stack, as taught by Sommers (Figure 5; column 3, lines 22-25; column 4, lines 16-28). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to apply the label-like protective members of Kinoian using a cut and stack method because such is known in the art, as taught by Sommers, wherein this method allows for high speed application of the members (Sommers; column 4, lines 25-28).

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Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Miyazaki (US 5863624, of record), as set forth in paragraph 15 of the final action.

Regarding claim 15, the adhesive 22 of Kinoian forms a stronger bond with the protective member than with the can such that no adhesive residue is left on the can after removal of the member (column 3, lines 19-24). Kinoian ensures this by using an adhesive which bonds more strongly to the member and less strongly to the can (column 3, lines 19-24).

It is known in the label art to increase bonding strength between an adhesive and a plastic layer (note the protective member of Kinoian is a flexible, plastic layer with indicia thereon - just like a label) by imposing treatment to the surface of the plastic layer before applying the adhesive thereto, as taught by Miyazaki (column 1, line 21; column 2, lines 64-68; column 5, lines 17-20; column 6, lines 15-18).

Therefore, it would have been obvious to the skilled artisan at the time the invention was made to ensure a stronger bond between the adhesive and protective member of Kinoian than that which exists between the adhesive and can by treating the protective member because such is known in the art, as taught by Miyazaki, wherein this serves as an alternative to using a particular adhesive that bonds more strongly to the members, thereby increasing the types of adhesives that can be used. As for a particular type of treatment, such would have been within purview of the skilled artisan at the time the invention was made absent any unexpected results; it being noted that chemical treatment (i.e. use of primers) is well-known and conventional.

Double Patenting

Claims 16 and 17 stand objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3 and 11, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 1-19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/360,488 for the reasons set forth in paragraphs 18-21 of the final action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

Appellant's arguments filed 3/13/06 have been fully considered but they are not persuasive.

On p. 13-14 of the arguments, Appellant argues that the combination of Kinoian and Bozlee constitutes hindsight because the reference to Bozlee is nonanalogous art since it teaches carrying bags with handles that can include advertising, whereas the present invention deals with protective members applied to beverage containers; therefore, Appellant contends that there is no reason to look to the bag handle art.

The examiner points out that Bozlee was only used to show it being known in the business method art to attach a flexible member to an object wherein the flexible member displays indicia in the form of advertising, which belongs to a third party who purchased the

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rights to display this advertising from the manufacturer of the flexible member. To rephrase, Bozlee was only relied upon for its teaching of a particular business method (selling advertising rights to a third party who is neither the flexible member supplier nor the supplier of the object to which the flexible member is attached) and not for the particular type of flexible member upon which the advertising is being placed.

Furthermore, the primary reference to Kinoian teaches advertising can be placed on the flexible protective member adhered to the beverage container, wherein one of ordinary skill in the art clearly would have been motivated to look to business method teachings relating to the sale of advertising rights, such as that of Bozlee, especially since Bozlee, like Kinoian, teaches this advertising being placed on a flexible member which is then attached to another object.

On p. 14 of the arguments, Appellant argues that neither Kinoian nor Bozlee teaches a substantially wrinkle free skin tight seal between the protective member and at least a portion of the mouth contact area of the container.

Appellant is invited to reread the rejection of claim 1, as set forth above, while paying close attention to the Figures and column 3, lines 10-25 and column 4, lines 24-25 of Kinoian, which clearly show the protective member of Kinoian being adhered to the containers to form a *substantially* wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the container.

On p. 15 of the arguments, Appellant argues that Kagami is silent on an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation, without heat shrink application and without wrinkling of a material of the protective member.

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The examiner would first like to point out that this argument is not commensurate with the scope of the claimed invention, as the present claims say nothing about heat shrink application.

The examiner would then like to invite Appellant to reread the rejection of claim 3 above. To reiterate, Kinoian teaches the protective member not being limited to a particular configuration wherein the configuration facilitates adherence to a top and convex side of a can without deformation and without wrinkling (Figures 1 and 3-6). However, the reference is silent as to an hourglass configuration. It would have been obvious to the skilled artisan at the time the invention was made to use an hourglass configuration for the protective member of Kinoian because it is known to adhere an hourglass-shaped protective member to a top and convex side of a beverage can, as taught by Kagami (Figures 3-4; section [0010] written translation), wherein such a configuration conforms to the contours of the can well - note similarities between "hourglass" configuration of protective member in Figure 3 of Kagami and "hourglass" configuration of protective member in Figure 4 of present invention. Therefore, since the "hourglass" configuration of the present invention is responsible for the protective member facilitating adherence to a top and convex side of a can without deformation and without wrinkling of the protective member, the skilled artisan would have appreciated the "hourglass" configuration of the protective member of Kagami would also facilitate adherence without deformation and without wrinkling.

On p. 16 of the arguments, Appellant argues that Ruemer discloses only redeemable prizes and therefore no reference discloses games of chance, premiums, collectibles and redeemables. On p. 16-17 of the arguments, Appellant agrees that Kinoian teaches the indicia

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can be advertising or instructions, but that means there is no reference teaching games of chance, public service announcements and warnings.

The examiner would first like to point out that these arguments are not commensurate with the scope of the claimed invention for two reasons: 1) present claims 11 and 17 do not require that the protective member be used for all of these types of indicia; instead, the language "for such things as" implies that the printing could be any of the types listed without requiring that it be all of the types listed and 2) the present claims say nothing about public service announcements and warnings. Applicant is now invited to reread the rejection of claims 11 and 17 above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JESSICA ROSSI
PRIMARY EXAMINER

Jessica Rossi

Conferees:

RC

[Signature]

SG

[Signature]